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| Notice of Allowability | Application No. | Applicant(s) |
| | 10/067,318 | STEBBINGS ET AL. |
| | Examiner | Art Unit |
| | Ahshik Kim | 2876 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. This communication is responsive to Terminal Disclaimer filed on 8/18/03.
2. The allowed claim(s) is/are 20-22, 25-46.
3. The drawings filed on 07 February 2002 are accepted by the Examiner.
4. Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some*
 - c) None
 of the:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

5. Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - (a) The translation of the foreign language provisional application has been received.
6. Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. CORRECTED DRAWINGS must be submitted.
 - (a) including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) hereto or 2) to Paper No. _____.
 - (b) including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet.

9. DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

| | |
|--|---|
| <input type="checkbox"/> Notice of References Cited (PTO-892) | <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. _____. |
| <input type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. _____. | <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | <input type="checkbox"/> Other |

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on August 18, 2003 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US Patent No. 6,477,134 to Stebbings et al. has been reviewed and is accepted. The terminal disclaimer has been recorded.

Examiner's Amendment

2. Pursuant to the interview held on October 29 regarding a minor informalities in the claim 20 (see enclosed interview summary), following is a complete set of claims presented in the examination.

20. (Currently Amended) A method for authenticating a data media storing data in order to prevent at least one of piracy, unauthorized access and unauthorized copying of said data media, wherein at least a data area of said media is impregnated with at least one predetermined tracing substance including a predetermined concentration of at least one of an isotope, a plurality of isotopes and a plurality of stable isotopes, to form at least one security marking used for at least one of tracking and authenticating said data media, said method comprising the steps of:

(a) detecting the at least one security marking in said data area of said data media;

(b) authenticating said data media responsive to said detecting step (a) using the at least one security marking; and

(c) outputting said data stored on said data media as at least one of audio, video, audio data, video data and digital data substantially free of said at least one security marking when the data media has been successfully authenticated by said authenticating step (b).

21. (Previously Amended) The authenticating method according to claim 20, and further including the step of authenticating said data media via at least two different security markings, each of which successively must be authenticated before said data is finally output via said outputting step (c).

22. (Previously Amended) The authenticating method according to claim 20, and further including the step of authenticating said data media over a plurality of interconnected computer networks comprising at least one of a local network, global network and Internet.

25. (Previously Amended) The authenticating method according to claim 20, wherein said step of detecting the at least one security marking comprises detecting at least one of a transparent oxide of at least one of a silicate, a lead dioxide, tin, cadmium 12 and iridium 5, or combination thereof.

26. (Previously Amended) The authenticating method according to claim 20, wherein said step of detecting the at least one security marking comprises detecting using at least one of mass spectrometry, neutron absorption and neutron spectrometry techniques.

27. (Previously Amended) The authenticating method according to claim 20, wherein said step of detecting the at least one security marking comprises reading information from said data area of said data media.

28. (Previously Amended) A system for authenticating a data media storing data in order to prevent at least one of piracy, unauthorized access and unauthorized copying of said data media, wherein at least a data area of said media is impregnated with at least one predetermined tracing substance including a predetermined concentration of at least one of an isotope, a plurality of isotopes and a plurality of stable isotopes, to form at least one security marking used for at least one of tracking and authenticating said data media, said system comprising:

 a sensor that detects the presence of the at least one security marking in said data area of said data media;

 a processor that is capable of authenticating said data media using the at least one security marking; and a playback device that is capable of outputting said data stored on said data media as at least one of audio, video, audio data, video data and digital data substantially free of said at least one security marking when the data media has been successfully authenticated.

29. (Previously Amended) The system according to claim 28, wherein said processor authenticates said data media via at least two different security markings, each of which successively must be authenticated before said data is finally outputted.

30. (Previously Amended) The system according to claim 28, wherein said processor authenticates said data media over a plurality of interconnected computer networks comprising at least one of a local network, global network and Internet.

31. (Previously Amended) The system according to claim 28, wherein said sensor detects the at least one security marking by detecting at least one of a transparent oxide of at least one of a silicate, a lead dioxide, tin, cadmium 12 and iridium 5, or combination thereof.

32. (Previously Amended) The system according to claim 28, wherein said sensor detects the at least one security marking by using at least one of mass spectrometry, neutron absorption and neutron spectrometry techniques.

33. (Previously Amended) The system according to claim 28, wherein said sensor detects the at least one security marking by reading information from said data area of said data media.

34. (Previously Amended) The system according to claim 28, wherein said outputted at least one of said audio, video, audio data, video data and digital data is stored in said data area of said data media.

35. (Previously Amended) A system for authenticating a data media storing data in order to prevent at least one of piracy, unauthorized access and unauthorized copying of said data media, wherein at least a data area of said media is impregnated with at least one predetermined tracing substance including a predetermined concentration of at least one of an isotope, a plurality of isotopes and a plurality of stable isotopes, to form at least one security marking used for at least one of tracking and authenticating said data media, said system comprising:

means for detecting the at least one security marking in said data area of said data media;

means for authenticating said data media responsive to said means for detecting using the at least one security marking; and

means for outputting said data stored on said data media as at least one of audio, video, audio data, video data and digital data substantially free of said at least one security marking when the data media has been successfully authenticated by said means for authenticating.

36. (Previously Amended) The system according to claim 35, wherein said means for authenticating authenticates said data media via at least two

different security markings, each of which successively must be authenticated before said data is finally outputted.

37. (Previously Amended) The system according to claim 35, wherein said means for authenticating authenticates said data media over a plurality of interconnected computer networks comprising at least one of a local network, global network and Internet.

38. (Previously Amended) The system according to claim 35, wherein said means for detecting the at least one security marking comprises means for detecting at least one of a transparent oxide of at least one of a silicate, a lead dioxide, tin, cadmium 12 and iridium 5, or combination thereof.

39. (Previously Amended) The system according to claim 35, wherein said means for detecting the at least one security marking comprises means for detecting using at least one of mass spectrometry, neutron absorption and neutron spectrometry techniques.

40. (Previously Amended) The system according to claim 35, wherein said means for detecting the at least one security marking comprises means for reading information from said data area of said data media.

41. (Previously Amended) The system according to claim 35, wherein said outputted at least one of said audio, video, audio data, video data and digital data is stored in said data area of said data media.

42. (Previously Amended) A computer readable medium for authenticating a data media storing data in order to prevent at least one of piracy, unauthorized access and unauthorized copying of said data media, wherein at least a data area of said media is impregnated with at least one predetermined tracing substance including a predetermined concentration of at least one of an isotope, a plurality of isotopes and a plurality of stable isotopes, to form at least one security marking used for at least one of tracking and authenticating said data media, said computer readable medium comprising:

computer readable instructions for detecting the at least one security marking in said data area of said data media;

computer readable instructions for authenticating said data media responsive to said computer readable instructions for detecting using the at least one security marking; and

computer readable instructions for outputting said data stored on said data media as at least one of audio, video, audio data, video data and digital data substantially free of said at least one security marking when the data media has been successfully authenticated.

43. (Previously Amended) The computer readable medium according to claim 42, wherein said computer readable instructions for detecting the at least one security marking comprises computer readable instructions for detecting at least one of a transparent oxide of at least one of a silicate, a lead dioxide, tin, cadmium 12 and iridium 5, or combination thereof.

44. (Previously Amended) The computer readable medium according to claim 42, wherein said computer readable instructions for detecting the at least one security marking comprises computer readable instructions for detecting using at least one of mass spectrometry, neutron absorption and neutron spectrometry techniques.

45. (Previously Amended) The computer readable medium according to claim 42, wherein said computer readable instructions for detecting the at least one security marking comprises computer readable instructions for reading information from said data area of said data media.

46. (Previously Amended) The computer readable medium according to claim 42, wherein said outputted at least one of said audio, video, audio data, video data and digital data is stored in said data area of said data media.

Allowable Subject Matter

3. Claims 20-22 and 25-46 are allowed.

4. The following is the Examiner's statement of reasons for allowance: claims are directed at methods and system for authenticating a data in the data storage media in order to prevent unauthorized copying and use of the storage. However, previously cited references, taken alone or in combination, fail to suggest or teach that authenticating steps includes at least two different security markings, each of which must be successively authenticated before accessing data. Applicant further claims that the authentication can be performed over a plurality of interconnected computer networks comprising at least of local network, global network and Internet.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published

in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Patent Examiner
Art Unit 2876
November 7, 2003



DIANE I. LEE
PRIMARY EXAMINER